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10/561,106	12/16/2005	Franz Knauseder	1469-053129	1988
28289 7590 10/28/2008 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				
EXAMINER				
FIGUEROA, ADRIANA				
ART UNIT		PAPER NUMBER		
3633				
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10/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,106

**Applicant(s)**

KNAUSEDER, FRANZ

**Examiner**

Adriana Figueroa

**Art Unit**

3633

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/308)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 26-34, 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent (WO 2002/103135 A1). Konzelmann (US 2004/0168392 A1) is being used as a translation of the German patent and all the figures and paragraphs used as reference in the rejection are from this patent.

Regarding claim 26, German Patent discloses a structure comprising of at least first (1), second (2) and third identical boards, having planar surfaces (3) (Figure 1), and laterally mounted locking elements (5, 6), along a common joint (4), said locking elements (5, 6) being wedge shaped and having surfaces relative to the common joint that decrease or increase entirely along the joint in a linear manner (X), (annotated Figure 1, Detail A indicates the decrease or increase), wherein the locking elements are made in such a way that simultaneously, by displacing the first board (1) relative to the second board (2) along a first common joint (4), the first board can be connected with the second board in a positive fit along the first common connecting joint, both in a perpendicular direction relative to the planar surface of the board (3), as well as in a parallel direction relative to the planar surface (3) of the board, and, at the same time, in a perpendicular direction relative to the first common joint (4), and the first board (1) can

be connected with a third board in a positive fit along a second common connecting joint (j), at least in a perpendicular direction relative to the surface of the board, (Figure 1).

Regarding claim 27, German Patent discloses a structure having all or some of the locking elements (5, 6) are made in such a way that the displacement can take place exclusively in one plane that is parallel relative to the surface (3) of the boards, (Figure 1), (Paragraph 56). Examiner takes this position because this is possible when one board is lowered in a vertical direction and then slide towards the other board in a direction that is parallel relative to the planar surface.

Regarding claim 28, German Patent discloses the first common connecting joint (4) runs in a perpendicular direction relative to the second common connecting joint (j), (annotated Figure 1).

Regarding claim 29, German Patent discloses boards (1, 2) having laterally mounted locking elements (5, 6) with which two boards can be connected with each other laterally in an adhesive-free manner by positive fit, wherein the locking elements (5, 6) are made in such a manner, that there is an initial position into which the boards can exclusively be brought by lowering in a vertical direction, wherein a common joint (4) is formed between the boards in which a play occurs, and there is a final position in which the boards (1, 2) are interlocked by positive fit in a vertical direction and in which no play occurs at the common joint (4) and wherein the panels may be connected with each other in an adhesive-free manner, (Figure 1), (Paragraph 56-58).

Regarding claim 30, German Patent discloses boards (1, 2) that may be brought from the initial position into the final position by displacement along the common joint (4), (Figure 1), (Paragraph 56).

Regarding claim 31, German Patent discloses the boards (1, 2) having the locking elements (5, 6) being such that the boards can be brought into the initial position when, along the common connecting joint (4), they are arranged offset relative to one another by more than 50% and less than 100%, (Figure 1), (Paragraph 56).

Regarding claim 32, German Patent discloses the boards (1, 2) having an intermediate position in which the boards at least in a vertical direction, are interlocked by positive fit and in which a play occurs at the common joint (4) of the two boards, (Paragraph 56). Examiner takes this position because this is possible during the process of sliding one board towards the other before the final position.

Regarding claim 33, German Patent discloses boards (1, 2), wherein as a locking element has a perpendicular groove (s) that is inserted in a perpendicular direction relative to the planar surface (3), and the other board has at least a corresponding protruding perpendicular locking element (r) which arrives in the perpendicular groove when the boards are in the initial position, wherein the perpendicular groove and a lateral boundary of the perpendicular groove (s), at least in part, have a course that does not run parallel relative to the common joint (4), and the perpendicular locking element (r) and a lateral boundary of the perpendicular locking element at least in part have such a course that does not run parallel relative to the common joint (4), (annotated Figure 1).

Regarding claim 34, German Patent discloses boards (1, 2) wherein, in the final position, a lateral boundary (10) of the perpendicular groove adjoins a lateral boundary (16) of the perpendicular locking element (r) intimately, (annotated Figure 1).

2. Claims 35-37, 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent (WO 2002/103135 A1) in view of McBurney (US 2,016,382).

Regarding claim 35, German Patent discloses boards (1, 2) as discussed above, but does not disclose at least one lateral boundary of the perpendicular groove and a lateral boundary of the perpendicular locking element is formed wedge-shaped, in particular has such a course relative to the common joint that the distance to the common joint decreases or increases along the joint in a linear manner. However, McBurney teaches at least one lateral boundary of the perpendicular groove (12) and a lateral boundary of the perpendicular locking element (13) is formed wedge-shaped, in particular has such a course relative to the common joint (j) that the distance to the common joint decreases or increases along the joint in a linear, (annotated Figure 5). Therefore, it would have been obvious to substitute the locking elements (r, s) of German Patent with the locking elements of McBurney since this would have yielded predictable results, which is an interlocking action to one of ordinary skill in the art at the time of the invention such as interlocking floor boards.

Regarding claim 36, German Patent discloses boards (1, 2) wherein, at least one lateral wall (16) of a groove (7) that is provided as a locking element runs in an arched, wave-like, serpentine or sawtooth-like manner, (Figure 1), (Paragraph 68).

Regarding claim 37, German Patent discloses boards (1, 2) wherein there is at least one contact area (walls 10, 16) between two locking elements (7, 9) which area runs in a perpendicular direction relative to the surface (3), (Figure 1).

Regarding claim 38, German Patent discloses boards (1, 2) wherein there is at least one contact area between two locking elements (7, 9) formed by undercuts, (Figure 1).

Regarding claim 39, German Patent discloses boards (1, 2) wherein one board laterally has, as a locking element, at least one groove (5) and another board laterally has at least one tongue (6), (Figure 1).

Regarding claim 40, German Patent discloses boards (1, 2) wherein the bottom surface (a) of a lateral tongue (p) forms a continuous flat surface with the bottom (b) of a vertical locking element (r), (annotated Figure 1).

Regarding claim 41, German Patent discloses boards (1, 2) wherein a bottom groove-cheek (c) of a lateral groove (q) forms a flat surface with the bottom (d) of the perpendicular groove (s), (annotated Figure 1).

Regarding claim 42, German Patent discloses boards (1, 2) that can be connected by means of a paste or, in particular an adhesive between two interlocked boards, (Paragraph 72).

Regarding claim 43, German Patent discloses boards (1, 2), having a moisture repellant paste or adhesive mass between two boards which adjoins the surface of the boards, (Paragraph 46).

Regarding claims 44 and 45, German Patent discloses boards (1, 2), wherein the boards are laminate flooring panels, (Figure 1), (Paragraphs 3, 80).

Regarding claim 46, German Patent discloses a method for connecting at least first, second and third boards having planar surfaces (3) with laterally mounted locking elements (5, 6), in particular of boards comprising the steps of: displacing the first board (1) relative to the second board (2) along a first common connecting joint (4),

wherein simultaneously the first board is connected with the second board in a positive fit along the first common connecting joint, both in a perpendicular direction relative to the planar surface of the board, and in a parallel direction relative to the planar surface of the board, and, at the same time, in a perpendicular direction relative to the first common connecting joint, and the first board capable of being connected with the third board in a positive fit along a second common connecting joint (a), at least in a perpendicular direction relative to the planar surface of the board, (annotated Figure 1), (Paragraph 55).

Regarding claim 47, German Patent discloses a method wherein the displacement occurs exclusively in one plane parallel relative to the surface (3) of the board, (Paragraph 56). Examiner takes this position because this is possible when one board is lowered in a vertical direction and then slide towards the other board in a direction that is parallel relative to the planar surface.

Regarding claim 48, German Patent discloses a method wherein the first connecting joint (4) runs in a perpendicular direction relative to the second common connecting joint (a), (annotated Figure 1).



Regarding claim 49, German Patent discloses a method for connecting at least first (1) and second (2) boards with laterally mounted locking elements (5, 6), wherein two of the boards being connected laterally by positive fit in an adhesive-free manner, comprising the following steps: bringing the boards into an initial position, in particular, exclusively by lowering in a vertical direction, wherein a common joint (4) is formed between the boards in which a play occurs, and bringing the boards into a final position, in which the boards are interlocked in a vertical direction by positive fit, and in which no play occurs at the common joint (4) and the panels are connected in an adhesive-free manner, (Figure 1), (Paragraphs 56-59).

Regarding claim 50, German Patent discloses a method wherein the boards (1, 2) are brought from the initial position into the final position by displacement along the common connecting joint (4), (Paragraph 56).

Regarding claim 51, German Patent discloses a method wherein the locking elements (5, 6) are such that the boards can be brought into the initial position when, along the common connecting joint (4), they are arranged offset relative to one another by more than 66% and less than 80%, (Paragraph 56).

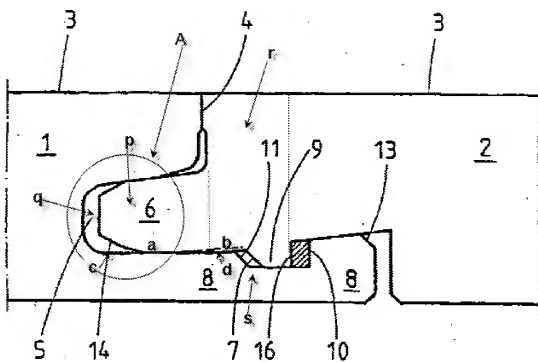
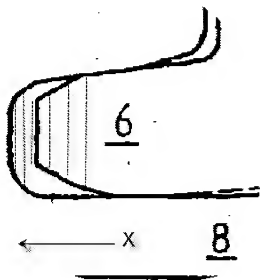


FIGURE 1, Konzelmann (US 2004/0168392 A1)



Detail A

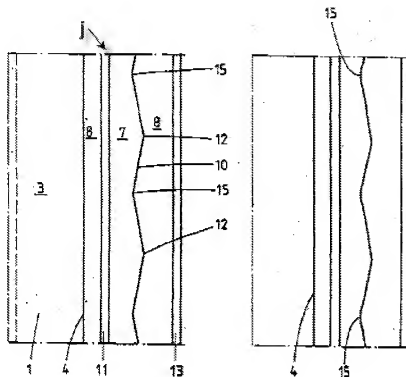


FIG. 1

Konzelmann (US 2004/0168392 A1)

### Response to Arguments

3. Applicant's arguments filed 7/23/2008 have been fully considered but they are not persuasive.
4. In response to applicant's argument with regard to claim 29. Examiner asserts that the boards of the German patent that are capable of being brought together in the same manner as the boards of the claimed invention. First lowering in a vertical direction to an initial position and then moved to a final position. There is not indication

in the claims that the boards are brought together "without rotation of one board relative to the other".

5. In response to applicant's argument with regard to claim 46. Examiner wants to note that the boards of the instant application require the engagement of the tongue into the groove prior to the displacement as indicated in Figure 2b. Examiner asserts that the boards of the German patent are capable of being connected in the same manner than the boards of the claimed invention.

6. In response to applicant's argument with regard to claim 31. Examiner asserts that the boards of the German patent meet this limitation. Paragraph 56 of the German patent discloses that the boards are brought together to an initial position which indicates that there is a gradual displacement that at some point will be more than 50 percent and less than 100 percent.

7. In response to applicant's argument that *McBurney* is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, *McBurney* teaches a wedge-shaped connection between two boards.

In addition, Examiner wants to note that where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement", the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83

USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396 (2007)). Accordingly, since the Applicant has submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another that would perform the same action which is the interlocking of the boards.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adriana Figueroa whose telephone number is 571-272-8281. The examiner can normally be reached on Monday-Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./

Application/Control Number: 10/561,106

Page 15

Art Unit: 3633

Supervisory Patent Examiner, Art Unit 3635

/A. F./

Examiner, Art Unit 3633

10/24/2006